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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------------|------------------|
| 09/843,922 | 04/30/2001 | Masayuki Fukumura | 4001-0003CIP | 2336 |
| 26111 | 7590 | 09/18/2006 | | |
| STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005 | | | | |
| | | | EXAMINER KELLY, ROBERT M | |
| | | | ART UNIT 1633 | PAPER NUMBER |

DATE MAILED: 09/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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|---|-------------------------------|---------------------------------|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. 09/843,922 | Applicant(s) FUKUMURA ET AL. | |
| | Examiner Robert M. Kelly | Art Unit 1633 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: none.
 Claim(s) objected to: none.
 Claim(s) rejected: 16-18 and 22.
 Claim(s) withdrawn from consideration: none.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). 5/26/04; 7/28/04
 13. ☒ Other: See Continuation Sheet.

Joe Winters
AW 1632

Continuation of 5. Applicant's reply has overcome the following rejection(s): Applicant's filing of a terminal disclaimer overcomes the obviousness-type double patenting rejection of claims 16-18 and 22 over US PAT NO 6,723,532 and the various references cited. Applicant's filing of a declaration of common ownership at the time of filing between the present Application and US PAT NO 6,723,532 overcomes all the rejections under 35 USC 103(a) based on Nagai.

Continuation of 11. does NOT place the application in condition for allowance because: The various rejections of Claims 16-18 and 22 remain under 35 USC 103(a) under the basis of US Pat No 6,514,728, although the rejection to Claim 17 is withdrawn only to that basis that the claim was rejected for containing the limitation to FGF-2. Applicant's argument is that they have priority to Japanese Patent Application No. 10/204,333, filed July 3, 1998, and therefore, is prior art to US Pat No 6,514,728. Such is not persuasive, as Applicant's first US filed Application is considered their PCT document, and Applicant states that such document was filed on July 1, 1999. Further, Applicant's Japanese filing, filed July 3, 1998, overcomes all rejections under 35 USC 102(a) art up to that date. However, the priority of US PAT No. 6,514,728 goes all the way back to February 6, 1998, as noted on the face of the patent. Hence, such priority is earlier than Applicant's earliest filing, as well as being over one year earlier than their earliest US filing. Therefore, Kai remains a solid basis of rejection, combined with the other references, over claims 16-18 and 22. Applicant also claims benefit of their PCT application is earlier than the earliest filed US Application of the US Pat No 6,514,728 to Kai. However, such is an incorrect comparison. If Applicant should have benefit of their PCT application, as is proper, Kai should also have benefit of their PCT filing, as they also claim benefit under 35 USC 371. Hence, Applicant is not making the correct comparison. Kai's PCT Application was filed January 29, 1999, which is earlier than Applicant's PCT filing.

Continuation of 13. Other: Included in this Advisory Action are the requested IDS sheets, signed and initialed by the Examiner. It is noted that Applicant did not receive these due to inadvertent error on the part of the Examiner, however the references were previously considered. With regard the matter of correspondence address, while it is not within the perview of the Examiner to determine power of attorney, changes of address, or whether Applicant can obtain a refund on their argued basis, the Examiner has notified the proper authorities to review this Application and correct any situation required to be corrected. Further, in order help Applicant, it is noted that Applicant's filing of change in power of attorney was responded to in Office Responses of 9/28/04 and again on 10/4/04, mailed to Mark Shanks, Reed Smith LLP, 1301 K Street NW, Suite 1100 East Tower, Washington, DC 2005-3373. Each response made clear that the power of attorney was not accepted, at least on the basis of having listed more than 10 practitioners listed. With regard to the filing of a copy of the power of attorney on 1/5/06, it appears that such filing, labelled "COPY" was not considered by the office, as no acknowledgement of acceptance was issued from the office. However, it is noted that this copy also contains a listing of more than 10 practitioners, and applicant was on notice from the previous non-acceptance letters that such made the declaration of power of attorney defective and not acceptable. Again, it is not within the Examiner's perview to consider these issues, but it appears that Applicant was on full notice of non-acceptance of power of attorney, and refiling the same document should reasonably not change the response. However, the proper authorities have been notified prior to the mailing of this action, and hopefully a satisfactory resolution is made for Applicant.